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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,003	11/07/2001	Shiguang Yu	6601-00	5003

49144 7590 03/28/2005

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/683,003	YU ET AL.	
	Examiner	Art Unit	
	Frank I. Choi	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/3/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treatment of poor hair growth or alopecia, does not reasonably provide enablement for prevention of poor hair growth or alopecia. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The nature of the invention:

The claims are directed to prevention or treatment of poor hair growth or alopecia with about 0.1 to about 4.5 mg/Kg of selenium.

The state of the prior art and the predictability or lack thereof in the art:

The prior art of record provides evidence of treatment but not prevention of poor hair growth or alopecia. As such, it appears that prevention is of low predictability.

The amount of direction or guidance present and the presence or absence of working examples:

Applicant provides only an example in which hair is directly removed, as such, there is no showing of prevention of poor hair growth or alopecia.

The breadth of the claims and the quantity of experimentation needed:

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The claims are broad in that they claim prevention, however, Applicant has not shown that administration of selenium does prevent poor hair growth or alopecia. As such, it appears that one of ordinary skill in the art would be required to do undue experimentation in order to determine whether prevention occurred.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(a or e) as being anticipated by Shields, Jr. et al. (US Pat. 6,156,355) or Hayek et al. (US Pat. 6,238,708).

Shields, Jr. et al. expressly disclose a composition containing a minimum of 0.4 mg/kg or selenium (Example 4, Column 19, lines 63-68, Column 20)

Hayek et al. expressly disclose a composition containing 0.27 mg/kg of selenium (Table 8, Column 18, lines 44-68, Column 19, lines 1-18).

Claims 1, 3, 4 are rejected under 35 U.S.C. 102(b) as being anticipated by McDonald (Abstract).

McDonald discloses that oral administration of 0.1 mg/kg or selenium to lambs resulted in fleece weight which was 14.4% higher and wool production which was 39% higher than surviving untreated lambs (Abstract).

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/11122, Lee et al., Shield, Jr. et al., Hayek et al., Arthur et al., Ahsan et al. and Messenger.

WO 98/11122 disclose that low levels of selenium have be associated with hair abnormalities (pg. 2, lines 9-14). It is disclosed that the nutritional supplement contains a dosage of about 10 micrograms to about 5 mg (Pg. 10, lines 16,17). It is disclosed that the nutritional supplement has application in the veterinary fields (Abstract).

Lee et al. (Aust. J. Agric. Res. (1999)) disclose that recommended dietary selenium requirement in the US for sheep is 0.1-0.3 mg/kg and that the critical concentration of Se in blood necessary to support wool growth is 900 nmol Se/L for breeding ewes and 500 or 800 nmol Se/L for non-breeding sheep Pgs. 1344,1345).

Shields, Jr. et al. disclose a composition which is fed to dogs containing a minimum of 0.4 mg/kg or selenium (Example 4, Column 19, lines 63-68, Column 20)

Hayek et al. disclose a composition which is fed to dogs containing 0.27 mg/kg of selenium (Table 8, Column 18, lines 44-68, Column 19, lines 1-18).

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Arthur et al. disclose that selenium deficiency impairs thyroid hormone metabolism by inhibiting the synthesis and activity of the iodothyronine deiodinases which convert thyroxine to the more metabolically active triiodothyronine (T3) (Abstract).

Ahsan et al. disclose that triiodothyronine stimulates the proliferation and/or metabolism of outer root sheath cells and dermal papilla cells (Abstract).

Messenger discloses that thyroxine, which is converted to the active hormone triiodothyronine, increased hair length in rats and hair growth in sheep and badgers (pg. 633).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a method for controlling the rate of hair growth or treating poor hair growth or alopecia in a dog or cat with about 0.1 to about 4.5 selenium mg/kg. However, the prior art amply suggests the same as it is disclosed that selenium is critical to wool production, that selenium is given as a nutrient supplement in animals, including dogs and that selenium deficiency results in T3 deficiency, that T3 stimulates hair cell growth and/or metabolism and that administration of thyroxine, which is converted to T3 by an enzyme which requires selenium, is effective in growing hair in sheep and badgers. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to administer similar amounts of selenium to dogs or cats with the expectation that selenium administration would control the rate of hair growth or treat poor hair growth or alopecia.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

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A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Gary Kunz, can be reached at 571-272-0887. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FIC

March 17, 2005



JOHN PAK
PRIMARY EXAMINER
Art Unit 1616